

REMARKS/AGRUMENTS

Reconsideration of this application, as amended, is respectfully requested. The following remarks are responsive to the Office Action mailed December 22, 2003.

Claims 1-31 are pending.

Claim 21 has been amended.

It is respectfully submitted that no new matter is presented.

Claims 1-31 are rejected under 35 U.S.C. §103(a) as being anticipated by U.S. Patent 6,014,662 of Moran, et al. ("Moran") in view of U.S. Patent No. 6,446,065 of Nishioka, et al. ("Nishioka").

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1-31 under 35 U.S.C. §103(a) as being unpatentable over Moran in view of Nishioka. Applicants disagree and submit that claims 1-31 are patentable under 35 U.S.C. §103 in view of the references cited by the Examiner.

In regard to the rejection of claims 1, 10, 16, and 27 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Moran reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the keyword searching nor does it explicitly indicate the catching [sic] feature. However, Nishioka discloses keyword searching (Col 2, Lines 16-21) and caching the search result (Col 2, Lines 38-55).

(12/22/03 Office Action, p. 3).

Applicants submit that claims 1-31 are not obvious in view of Moran and Nishioka. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Moran, and Nishioka.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of December 22, 2003, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a

determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claim 1, even if Moran and Nishioka were combined, such a combination would lack one or more features of claim 1. Amended claim 1 recites the feature of *catching the search results to maintain persistency of the search results*. (emphasis added) As shown by the following analysis, neither Moran, nor Nishioka disclose this feature as stated in applicants' claim 1. As the Examiner stated in his Office Action of December 22, 2003, the "Moran reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate ... the catching [sic] feature. However, Nishioka discloses ... catching the search result (Col 2, Lines 38-55)." Applicants respectfully disagree.

Nishioka also fails to disclose *catching the search results to maintain persistency of the search results*. (Claim 1) (emphasis added) *INTENDED AS* Nishioka describes a "Document Retrieval Assisting Method and System for the same and Document Retrieved Service using the same." (Nishioka, title). Nishioka states that "it is an object of the [Nishioka's] invention to attain that users can catch both individual information such as title list as search results and the over view of the search results..." (Nishioka, col. 2, ll. 25-28) As pointed out by the Examiner, Nishioka provides "that users might make attempts for improving search queries while catching the whole set of search results...." (Nishioka, col. 2, ll. 38-39). Additionally, Nishioka states that "*users can*

thereby catch instantly specific information (title list) of the search results and the whole abstract information..." (Nishioka, col. 7 l. 63- col. 8, l. 5). From, Nishioka's figures it is apparent that Nishioka uses the term "catch" to mean view, and not "caching the search results to maintain persistency of the search results," as stated in applicants' claim 1. Furthermore, nowhere in Nishioka's patent is there a discussion of caching, let alone caching the search results. Thus, because neither, Moran nor Nishioka disclose "caching the search results to maintain persistency of the search results", applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. §103(a) by Moran in view of Nishioka. Given that claims 2-9 depend from claim 1, applicant respectfully submits that claims 1-9 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected independent claim 10 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 10 discloses substantially similar limitations as claim 1, and recites "caching the search results to maintain persistency of the search results..." (Emphasis added) Because, neither Moran nor Nishioka disclose this feature as taught by applicants' claim 10 from which claims 11-15 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 10-15 are not made obvious under 35 U.S.C. §103(a) by Moran in view of Nishioka.

The Examiner also rejected independent claim 16 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 16 discloses substantially similar limitations as claim 1, and recites "a business service... to cache the search results to maintain persistency..." (Emphasis added) Because, neither Moran nor Nishioka disclose this feature as taught by applicants' claim 16 from which claims 17-20 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 16-20 are not made obvious anticipated under 35 U.S.C. §103(a) by Moran in view of Nishioka.

The Examiner also rejected independent claim 21 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 21 discloses substantially similar limitations

as claim 39, and recites “to cache search results to maintain persistency of the search results.”

(Emphasis added) Because Moran does not disclose these features as taught by applicants’ claim 21 from which claims 22-26 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 21-26 are not anticipated under 35 U.S.C. §102(b) by Moran.

The Examiner also rejected independent claim 27 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 1. Claim 27 discloses substantially similar limitations as claim 1, and recites “caching the search results to maintain persistency of the search results.” (Emphasis added) Because, neither Moran nor Nishioka disclose these features as taught by applicants’ claim 27 from which claims 28-31 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 27-31 are not made obvious under 35 U.S.C. §102(b) by Moran in view of Nishioka.

Applicants respectfully submit that all rejections have been overcome. Consideration of this amendment should lead to favorable action that would overcome all remaining grounds of objection and/or rejection.

If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: January 14, 2004 Sanjeet K. Dutta
Sanjeet K. Dutta
Reg. No. 46,145

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(408) 947-8200